



USSN: 10/648,759  
Atty Dkt: DURE-333  
PATENT

I hereby certify that this correspondence, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on 23 September 2010 in an envelope with sufficient postage as First Class Mail service pursuant to 37 C.F.R. §1.8, and addressed to: MS Petitions, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Signature: Crystal Susa Printed: Crystal Susa

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: BRODBECK, et al.

Title: Implantable Gel Compositions and Method of Manufacture

Serial No.: 10/648,759 Filing Date: 25 August 2003

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MS PETITIONS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RENEWED PETITION UNDER 37 C.F.R. §1.137(b)**

Sir:

This Submission is a Renewed Petition under 37 C.F.R. §1.137(b) to revive an application for patent abandoned unintentionally. A previous Petition to revive U.S. Patent Application Serial No. 10/648,759 under the Unavoidable (37 C.F.R. §1.137(a)) standard was submitted in this case on 12 September 2008, along with a Request for Continued Examination as the required Reply to accompany that Petition. The earlier Petition has been dismissed by way of the Decision dated 13 August 2010 from the Office of Petitions.

Applicants respectfully request reconsideration of their request to revive U.S. Patent Application Serial No. 10/648,759 on the basis that the application was abandoned unintentionally pursuant to 37 C.F.R. §1.137(b).

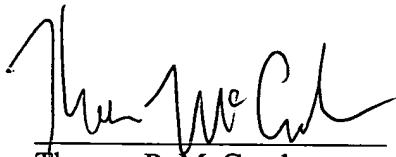
A Petition under 37 C.F.R. §1.137(b) accompanies this cover letter, along with the required Petition Fee set forth in 37 C.F.R. §1.17(m). Applicants further request that the Request for Continued Examination submitted with the previous Petition (dated 12 September 2008) be entered as the accompanying Reply as required by 37 C.F.R. §1.137(b), along with the RCE fee under §1.17(e) as also set forth in the 12 September 2008 submission.

### CONCLUSION

Applicants believe that this Submission is complete and sufficient to revive the subject patent application. However, if the Office contemplates other action, or if a telephone conference would expedite revival of the application, applicants invite the Office to contact the undersigned at (408) 777-4915.

The appropriate fee is either attached or authorized. If the Commissioner determines that an additional fee is necessary, the Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1953.

Respectfully submitted,



Thomas P. McCracken  
Registration No. 38,548

Date: 23 September 2010

For and on behalf of  
DURECT CORPORATION  
2 Results Way  
Cupertino, CA 95014  
Phone: (408) 777-4915  
Fax: (408) 777-3577

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)  
**DURE-333**

First named inventor: BRODBECK et al.

Application No.: 10/648,759

Filed: 25 August 2003

Art Unit: 1651

Examiner: Barnhart, Lora E.

Title: IMPLANTABLE GEL COMPOSITIONS AND METHOD OF MANUFACTURE

Attention: Office of Petitions

**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus any extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional

**1. Petition Fee**

☐ Small entity-fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Application claims small entity status. See 37 CFR 1.27.

☒ Other than small entity-fee \$ 1,620.00 (37 CFR 1.17(m))

**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in the form of Response to Final Action, RCE & RCE Fee (identify type of reply):

☒ has been filed previously on 12 September 2008.

☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ \_\_\_\_\_

☐ has been paid previously on \_\_\_\_\_.

☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

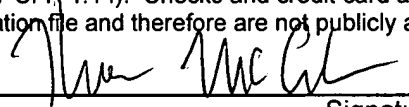
3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

  
\_\_\_\_\_  
Signature  
Thomas P. McCracken  
\_\_\_\_\_  
Type or Printed name  
DURECT Corporation  
\_\_\_\_\_  
Address  
2 Results Way, Cupertino, California 95014  
\_\_\_\_\_  
Address

23 September 2010  
\_\_\_\_\_  
Date  
38,548  
\_\_\_\_\_  
Registration Number, If applicable  
(408) 777-4915  
\_\_\_\_\_  
Telephone Number

Enclosures:

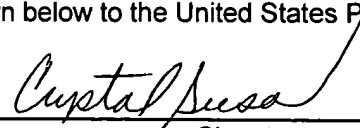
- ☒ Fee Payment
- ☐ Reply
- ☐ Terminal Disclaimer Form
- ☒ Additional sheets containing statements establishing unintentional delay
- ☒ Other: cover letter for Renewed Petition

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

- ☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- ☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

23 September 2010  
\_\_\_\_\_  
Date

  
\_\_\_\_\_  
Signature

Crystal Susa  
\_\_\_\_\_  
Typed or printed name of person signing certificate



The undersigned requests revival of this abandoned application pursuant to 37 CFR Sec. 1.137(b).

In brief, the required showing of unintentional abandonment is met because (A) a docketing error was the cause of the delay at issue, (B) docketing of responses due in files prosecuted by applicants before the USPTO is a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (C) the employee entrusted with the docketing function is highly trained and experienced such that reliance on the performance of that employee represents the exercise of due care. Additionally, the delay was discovered the day before the filing date of the earlier petition (12 September 2008), so the entire period of delay was unintentional.

The facts are described in more detail as follows.

The undersigned's employer, Durect Corporation ("Durect") acquired a very large patent estate from its previous owner. At the time, the estate was in spread out between numerous internal and external service providers, and the previous owner was unable to even provide a detailed docket that covered the entire estate. The estate was acquired in stages over a period from 12 December 2007 to May 22, 2008. Significant efforts to determine the actual scope of the estate, and to reconstruct the files within the estate were needed, including contacting former outside counsel of the previous owner, and searches of public databases.

As of the original petition date, applicants believe that over 740 individual files made up the acquired patent estate, with significant work being needed to review each file.

On 10 September, an outside counsel of the previous owner of the estate sent a message to Durect stating that they had received a Notice of Abandonment in another Application within the patent estate. This prompted applicants to review

the entire US portion of the patent estate. On 11 September, In the course of that review, applicants discovered that the present Application was abandoned for failure to reply to an Office Action (Final Rejection, with a mail date of 13 December 2007, and a Statutory Period for Response deadline of 13 June 2008).

A review of the file associated with this Application discovered that the Final Rejection had been received by the previous owner, but had not been properly docketed upon receipt of the file by Durect. A copy of applicants' docket is attached. It shows that no items had been docketed for 13 June 2008, the last day for the statutory period for responding to the Final Rejection. If the Final Response had been properly docketed, an entry noting the response due with a "Final" deadline would have appeared on applicants' docket.

The business routine established during acquisition of the patent estate that includes this Application was for the docketing specialist to review and docket all outstanding responses due in to the USPTO.

The Durect docketing specialist is highly trained and experienced, with 10 years of patent administrator experience (for US and foreign patent prosecution practice). The Durect Docketing specialist assists with the preparation and receipt of USPTO correspondence, and with the processing of all newly acquired files to determine any due dates for responding to USPTO Office Actions. The Durect docketing specialist is trained to recognize, and is experienced in recognizing, papers received from the USPTO, and to understand the due dates for response associated with such papers. Furthermore, the Durect docketing specialist is trained and is experienced with the docketing software used to produce applicants' docket.

Apparently, due to a clerical error, the due date for the Final Rejection was not entered into applicants' docketing system, as noted above. As a result, a

response to the Final Rejection was not filed within the statutory period for response, and the present Application became unintentionally abandoned.

The undersigned believes that revival is appropriate under 37 CFR Sec. 1.137(b) because the delay was unintentional. If the error had come to light prior to the abandonment of this Application, then applicants would have immediately filed the Request for Continued Examination that accompanied the initial Petition (dated 12 September 2008).

Redacted

Wednesday, May 28, 2008

Due Date: By Date

Page 1

Due Date Indicator	Action Due Action Type	Case Number/SubCase Country	Status Division	App Number Pat Number	App Date Iss Date	Attys
12-Jun-2008 Reminder	[REDACTED]	DURE343 / Israel Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DIA [REDACTED]
14-Jun-2008 Due Date	[REDACTED]	DURE306 / 0 United States of America Title: [REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	DIA [REDACTED]
14-Jun-2008 Reminder	[REDACTED]	Dure309 / Brazil Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DIA [REDACTED]
14-Jun-2008 Due Date	[REDACTED]	DURE335 / Australia Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DIA [REDACTED]
14-Jun-2008 Reminder	[REDACTED]	SBS102 / United States of America Title: [REDACTED]	Published	[REDACTED]	[REDACTED]	DIA [REDACTED]
15-Jun-2008 Reminder	[REDACTED]	DURE019 / 01 United States of America Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	TPM [REDACTED]
15-Jun-2008 Final	[REDACTED]	DURE301 / 2 United States of America Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DIA [REDACTED]
15-Jun-2008 Due Date	[REDACTED]	DURE325 / United States of America Title: [REDACTED]	Inactive	[REDACTED]	[REDACTED]	DIA [REDACTED]
15-Jun-2008 Reminder	[REDACTED]	DURE332 / 12 United States of America Title: [REDACTED]	Pending	[REDACTED]	[REDACTED]	DIA [REDACTED]